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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,571	05/23/2001	Thomas Himmler	M0-6341/LEA3	9929
7590 02/25/2004			EXAMINER	
Bayer Corporation 400 Morgan Lane West Haven, CT 06516-4175			ROBINSON, BINTA M	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/856,571	HIMMLER ET AL.	
	Examiner	Art Unit	
	Binta M. Robinson	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 12 is/are rejected.
- 7) ☒ Claim(s) 5-11 and 15-24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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Detailed Action

(old rejections)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmler. (See Reference N) for reasons of record at paper no. 11.

Himmler et. al. teaches the instant compound, 3-Quinolinecarboxylic acid, 8-cyano-1-cyclopropyl-6-fluoro-1,4-dihydro(octahydro-6H-pyrrolo[3,4-b]pyridin-6-yl)-4-oxo-, monohydrochloride; (4aS-cis)--. At page 15, lines 16-20, see Beispiel 2. The difference between the prior art compound and the instantly claimed compounds is the extent of the salt formation. In the instant compound, the salt is semi-hydrochloride of 8-cyano-1-cyclopropyl-7-(1S, 6S-2, 8-diazabicyclo-[4, 3, 0]nonan-8-yl)-6-fluoro-1, 4-dihydro-4-oxo-3-quinolnecarboxylic acid. In the Himmler compound, the salt is a monohydrochloride of 8-cyano-1-cyclopropyl-7-(1S, 6S-2, 8-diazabicyclo-[4, 3, 0]nonan-8-yl)-6-fluoro-1, 4-dihydro-4-oxo-3-quinolnecarboxylic acid. It's axiomatic in organic chemistry that acids will react with bases to form salts. Since there are several nitrogen atoms present in the instant compound, it is possible to form 1 to 3 acid-addition salts of HCL. It would have been obvious to one of ordinary skill to form a semihydrochloride from a

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monohydrochloride of the of 8-cyano-1-cyclopropyl-7-(1S, 6S-2, 8-diazabicyclo-[4, 3, 0]nonan-8-yl)-6-fluoro-1, 4-dihydro-4-oxo-3-quinolnecarboxylic acid. For instance, at page 15, lines 16-20 of the Himmeler reference, see Beispiel 2, where a disclosed species is exemplified. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.


Claims 5-11 and 15-24 are objected to because they are based on a rejected claim.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

Binta Robinson


February 23, 2004


CEILA CHANG
PRIMARY EXAMINER, Acting SPE
GROUP 1200/625